

REMARKS

The September 26, 2006 Office Action regarding the above-identified application has been carefully considered. The amendments above and these remarks are presented in a bona fide effort to respond thereto and address all issues raised in that Action. For reasons discussed below, it is believed that this case is in condition for allowance. Prompt favorable reconsideration of this amended application is requested.

The word "and" has been added to each pending claim, to improve grammar. Such an amendment, however, is not substantive in nature and should not alter claim scope.

Applicant filed three Information Disclosure Statements prior to the January 12, 2006 first Office Action. The first Office Action included document citation forms (PTO- 1449s) from the two latest Statements but not a signed copy of the two pages of such forms from the February 25, 2002 Statement that accompanied the original filing of this application. The second Office Action dated September 26, 2006 did not address this issue. It is noted that the February 25, 2002 Statement is included in the electronic file of this case available on Public PAIR on the Patent Office website. Hence, it is believed that that Statement was received with the application filing and is in the Official file of this matter. It is again requested that the Examiner consider all of the documents cited in the various Information Disclosure Statements, specifically including the documents cited in the February 25, 2002 Statement, as part of the reconsideration of this application, and that the Examiner indicate consideration by initialing the two pages of forms from the February 25, 2002 Statement alongside all of the citations and returning the initialed document listing pages with the next Official communication regarding this case.

Claims 43 and 44 are pending in this case. Both claims are independent.

The latest Office Action rejected claims 43 and 44 under 35 U.S.C. § 102(e) as anticipated by US patent no. 6,300,976 to Fukuoka. This rejection is traversed.

Claim 43 recites a picture information input means for inputting picture information, a picture information memory means and converting/sending means. The last paragraph of claim 43 recites the converting/sending means, as follows:

a converting/sending means for converting image data to be sent to said image forming apparatus to image data adapted to said image forming apparatus according to the picture information stored in said picture information memory means, and sending the converted image data.

As disclosed in this application, a digital camera includes means to convert image data that has been stored in a memory (MEM), which is to be sent to a printer, to a form thereof adapted for the printer (see abstract). The printer is an example of an image forming apparatus. In Applicant's first disclosed embodiment, for example, the picture information input means comprises the liquid crystal monitor 102 and the operation display section 116; the memory (MEM) 114 corresponds to the picture information memory means; and the converting/sending means comprises the CPU 113, IPP 107, DCT 108, coder 109, and MCC 110. Attention is directed to lines 4-11 of page 25 of the original specification of this application.

The rejection points to column 7, lines 16-65, of the Fukuoka patent for an alleged disclosure of converting/sending means. However, the rejection is deficient in that the cited text of Fukuoka does not in fact disclose the recited conversion function. As disclosed in the cited text, Fukuoka only teaches that files stored in the memory card 16 will be readable by a personal computer, and the files are stored according to the corresponding file format of the particular type of computer (column 7, lines 16-22). The cited patent text suggests that the camera can implement different file formats, in response to I/O files contained on different memory cards

(e.g. column 7, lines 29-33). However, the use of different file storage formats does not satisfy the claim requirement for converting “image data to be sent to said image forming apparatus to image data adapted to said image forming apparatus according to the picture information stored in said picture information memory means” (emphasis added), as recited in claim 43. Hence, Fukuoka does not disclose the recited converting function, and that function distinguishes claim 43 over Fukuoka.

Also, to show a prima facie case of anticipation with respect to a means plus function limitation, such as the converting/sending means, a rejection must identify an element in the allegedly anticipatory reference that performs the claimed function AND is equivalent to the element performing the claimed function in the present application. The rejection of claim 43 did not provide such a rigorous analysis of the elements disclosed in this case and Fukuoka and as a result did not provide a prima facie showing that Fukuoka disclosed a converting/sending means element, within the scope of the properly construed claim.

In view of the above-discussed functional distinction over Fukuoka and/or the improper failure to make a prima facie showing of a converting/sending means in Fukuoka, it is believed that the anticipation rejection of claim 43 is improper and should be withdrawn.

Claim 44 recites a digital camera, including picture information input means, a picture information memory means, and a converting/sending means. Claim 44 recites the converting/sending means in the following manner:

a converting/sending means for converting image data to be sent to said external device to image data adapted to said external device according to the picture information stored in said picture information memory means, and sending the converted image data.

As such, claim 44 expressly requires that this means converts image data to be sent to an image forming apparatus into image data adapted to the image forming apparatus according to the picture information stored in the picture information memory. The rejection apparently relied on column 7, lines 16-65, of the Fukuoka patent for an alleged disclosure of such a converting/sending means. It is respectfully submitted, however, that the cited text of Fukuoka does not disclose the recited conversion function. To the contrary, the cited portion of Fukuoka only suggests storing image data in a file format compatible with a particular type of computer that may be used to read the image data from the memory card, although different file formats may be implemented if memory cards store different I/O control files. Attention again may be directed to column 7, lines 16-22, and lines 29-33, in the Fukuoka patent. Storage in different formats does not suggest the claimed conversion of image data adapted that is to be sent to an external device into image data adapted to the external device according to picture information stored in the picture information memory.

Also, to show a prima facie case of anticipation with respect to a means plus function limitation, such as the converting/sending means, the rejection must identify an element in the allegedly anticipatory reference that perform the function recited in claim 44 AND is equivalent to the element performing the claimed function in the present application. The rejection of claim 44 did not provide such a rigorous analysis of the elements disclosed in this case and Fukuoka and as a result did not provide a prima facie showing that Fukuoka disclosed converting/sending means within the scope of properly construed claim 44.

In view of the above-noted functional distinction over Fukuoka and/or the improper failure to make a prima facie showing of converting/sending means in Fukuoka, it is believed that the anticipation rejection of claim 44 is improper and should be withdrawn.

Upon entry of the above claim amendments, claims 43 and 44 remain active in this application, both of which should be novel over the art. Applicant therefore submits that the remaining claims are in condition for allowance. Accordingly, this case should now be ready to pass to issue; and Applicant respectfully requests a prompt favorable reconsideration of this matter.

It is believed that this response addresses all issues raised in the September 26, 2006 Office Action. However, if any further issue should arise that may be addressed in an interview or by an Examiner's amendment, it is requested that the Examiner telephone Applicant's representative at the number shown below.

To the extent necessary, if any, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP



Keith E. George
Registration No. 34,111

600 13th Street, N.W.
Washington, DC 20005-3096
Phone: 202.756.8000 KEG:apr
Facsimile: 202.756.8087
Date: December 20, 2006

**Please recognize our Customer No. 20277
as our correspondence address.**